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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/504,812	08/13/2004	Mark Dominic Jackson	227	2113
31665	7590	11/06/2008		
PATENT DEPARTMENT MACROVISION CORPORATION 2830 DE LA CRUZ BLVD. SANTA CLARA, CA 95050				
EXAMINER				
PYZOCHA, MICHAEL J				
ART UNIT		PAPER NUMBER		
2437				
MAIL DATE		DELIVERY MODE		
11/06/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/504,812

Applicant(s)

JACKSON ET AL.

Examiner

MICHAEL PYZOSHA

Art Unit

2437

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 60-62, 64, 67, 69, 71-76 and 89-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 60-62, 64, 67, 69, 71-76 and 89-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 60-62, 64, 67, 69, 71-76 and 89-92 are pending.
2. Amendment filed 07/25/2008 has been received and considered.

Claim Rejections - 35 USC § 101

3. The rejections under 35 U.S.C. 101 have been withdrawn based on the filed amendment.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 60-62, 64, 67, 71-76, and 89-92 are rejected under 35 U.S.C. 102(b) as being anticipated by Hogan (US 5699434).

As per claims 64, 67, and 89-92, Hogan discloses a method of copy protecting an application, where the application is provided by an application file which is to be carried on an optical disc, the application incorporating information and control data, the method comprising: incorporating into the application file, before its application onto an optical disc, DSV data patterns which have been identified as capable of causing DSV problems when encoded onto an optical disc; wherein the DSV data patterns are

incorporated in the application file so they are accessed by a player or reader of the optical disc during use of the application file (see column 6 lines 42-57).

As per claim 60, Hogan discloses the information in the application file comprises one or more of: audio data, numerical data, text data, video data, graphics data, program data, animation data, and any other data (see column 6 lines 42-57).

As per claims 61 and 62, Hogan discloses the control information includes descriptors of the information and data enabling access to the information (see column 6 lines 45-48).

As per claim 71, Hogan discloses the DSV data patterns are chosen to ensure that the DSV has a significant absolute value (see column 6 lines 40-50).

As per claim 72, Hogan discloses the DSV data patterns are repeated patterns of values (see Fig 4 and column 6 lines 42-67).

As per claim 73, Hogan discloses the size of DSV data patterns is a predetermined amount (see column 6 lines 58-67)

As per claim 74, Hogan discloses the DSV data patterns are arranged to produce a DSV which has a rapid rate of change (see column 6 lines 20-25).

As per claim 75, Hogan discloses the DSV data patterns are arranged to produce a DSV which has a substantial low frequency component (see column 6 lines 42-57).

As per claim 76, Hogan discloses areas of data containing only zeros are incorporated in the application file in one or more areas located before and after areas containing the DSV data patterns (see column 5 lines 52-63).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan.

As per claim 69, Hogan fails to explicitly disclose the application file has control data incorporated in the application file or in a header to the application file, and further comprising including at least one pointer or offset in the control data which points to the location of the DSV data patterns in the application file. However, Official Notice is taken that at the time of the invention one of ordinary skill in the art would use a pointer or offset to point to the location of the DSV pattern. Motivation to do so would have been that these are common and well-known methods used.

Applicant has not traverses the Examiner's assertion of official notice therefore the common knowledge or well-known in the art statement is taken to be admitted prior art (see MPEP 2144.03).

Double Patenting

8. The Double Patenting rejection with 7334268 has been withdrawn based on the approved terminal disclaimer filed 06/11/2008.

Response to Arguments

9. Applicant's arguments filed 06/11/2008 have been fully considered but they are not persuasive. Applicant argues that Hogan fails to teach the limitations of claim 64.

10. With respect to Applicant's argument that Hogan fails to teach the limitations of claim 64, Hogan teaches a method of copy protecting an application (see column 6 line 45), where the application is provided by an application file which is to be carried on an optical disc (see column 6 line 45 and column 4 lines 52-59), the application incorporating information and control data (see column 6 lines 42-57), the method comprising: incorporating into the application file, before its application onto an optical disc (see column 6 lines 42-57 and column 4 lines 52-59 where the original data is encoded before it is written onto the disc), DSV data patterns which have been identified as capable of causing DSV problems when encoded onto an optical disc (see column 6 lines 42-57); wherein the DSV data patterns are incorporated in the application file so they are accessed by a player or reader of the optical disc during use of the application file (see column 6 lines 42-57 and column 4 lines 59-67). Applicant further argues that Hogan is performed at a different stage in the processing of optical discs which provides added benefit not realized by Hogan. However, these ideas are not reflected in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, Hogan teaches each limitation of claim 64.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL PYZOSKA whose telephone number is (571)272-3875. The examiner can normally be reached on Monday-Thursday, 7:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2437

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. P./

Examiner, Art Unit 2437

/Emmanuel L. Moise/

Supervisory Patent Examiner, Art Unit 2437